

### **REMARKS**

An Office Action has been issued in the subject application in which:

- 1) the claims were subject to a restriction requirement;
- 2) claims 1, 4, 5, 9, 16, 19, and 20 were rejected under 35 U.S.C. § 102; and
- 3) claim 1, 4, 5, 16, and 19 were rejected under 35 U.S.C. § 103.

Summarizing the Amendment, nonelected claims 11–15, 21, and 22 have been canceled, and claims 1, 4, 5, 9, and 16 have been amended to more distinctly claim and particularly point out the subject matter which Applicant regards as the invention. Claims 1, 4, 5, 9, 16, 19, and 20 remain in the application. Applicant reserves the right to prosecute the canceled claims and the previously canceled claims in one or more divisional applications.

Each of the rejections is traversed hereunder in the order presented in the Office Action. Reconsideration of the subject application as amended is respectfully requested.

### **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 1, 4, and 5 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,462,166 to Minton et al. Claims 1, 4, 5, 9, 16, 19, and 20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,321,513 to Meixner. Applicant traverses these rejections.

### **Requirements for Anticipation**

The Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.* [721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)] that an anticipation rejection under 35 U.S.C. § 102 “requires the disclosure of a single prior art reference of each element of the claim under consideration.” It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim” [*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)]. Likewise, the Court of Customs and Patent Appeals (CCPA) stated in *In re Wilder* [429 F.2d 447, 166 USPQ 545, 548 (C.C.P.A. 1976)]:

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. In effect, a prima facie case is made out whenever a reference is

shown to contain a disclosure which is specific as to every critical element of the appealed claims.

In other words, a prima facie case of anticipation is established when the Patent Office provides:

- a) a single reference
- b) that teaches or enables
- c) each of the claimed elements (arranged as in the claim)
- d) expressly or inherently
- e) as interpreted by one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of anticipation is not established. In the instant case, it is respectfully submitted that the Minton et al. and Meixner patents both fail to meet these requirements.

### **The Cited References**

#### U.S. Patent No. 5,462,166

U.S. Patent No. 5,462,166 to Minton et al. discloses an individually packaged disposable absorbent article comprising a sanitary napkin 20 packaged in a flexible package, such as a flexible wrapper 160. The flexible wrapper 160 is folded and sealed to enclose the sanitary napkin 20. The flexible wrapper 160 is unfolded to reveal the sanitary napkin 20. (See column 3, line 67, to column 4, line 7, and FIGS. 1-3).

The sanitary napkin 20 is folded as a unit with the flexible wrapper 160 along two longitudinally spaced apart and laterally extending fold axes 152 and 153. The fold axes 152 and 153 divide the flexible wrapper 160 into three panels 162, 164, and 166. The panels 162, 164, 166 form three wrapper layers when the flexible wrapper is folded along the fold axes 152 and 153. (See column 4, lines 56-62, and FIGS. 1 and 3.)

As discussed below, the Minton et al. patent fails to teach or suggest an absorbent article which is retained in packaging when the volume of the article is reduced by at least about 30%, as set forth in claims 1 and 16.

#### U.S. Patent No. 6,321,513

U.S. Patent No. 6,321,513 to Meixner discloses a method in which a packaging material can be used which compresses a product during or after a packaging procedure or exerts a uniform multi-side or all-side pressure on a packaged commodity. Meixner states that the

method is advantageous in the packaging of diapers, hygiene paper, sanitary pads or the like. Meixner also states that the volume of diapers can be compressed by up to half in accordance with his method. (See column 4, lines 23–31.)

As discussed below, the Meixner patent fails to teach or suggest packaging a single absorbent article so that the article is highly compact and portable.

### The Present Invention

The invention as set forth in claim 1 recites a highly compact and portable absorbent article that includes:

a packaging; and  
a compressed absorbent article ... ;  
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said absorbent article occupying a volume of space that is reduced by at least about 30% when said absorbent article is reconfigured from [a] normal condition to [a] compressed condition; and  
said compressed absorbent article being retained by said packaging.

The invention as set forth in independent claim 16 recites a method for packaging an absorbent article so that the absorbent article is compact and portable. The method includes:

providing an absorbent article ... ;  
reconfiguring the absorbent article such that the volume of space is reduced by at least 30%;  
retaining the absorbent article when reconfigured within a packaging.

### **Discussion**

#### Rejections in view of Minton et al.

As mentioned above, the Minton et al. patent fails to teach or suggest a compressed absorbent article retained by packaging. In addition, Minton et al. fail to teach or suggest reconfiguring an absorbent article so that the volume is reduced by at least 30%, as recited in claim 1. In contrast, the Minton et al. patent discloses folding a sanitary napkin along fold axes (152, 153). By doing so, the overall length of the sanitary napkin is inherently reduced. However, Minton et al. are silent as to the extent of their reduced length. Furthermore, Minton et al. are also silent as to reducing the volume of their sanitary napkin.

Minton et al. discuss compression at column 6, lines 27 and 28, of their patent. However, their discussion focuses on compression of the individually wrapped sanitary napkins subsequent to assembly and packaging. In other words, the Minton et al. patent does not teach the

compression of the sanitary napkin and then packaging a compressed sanitary napkin to packaging. Accordingly, subsequent compression of Minton et al.'s individually wrapped sanitary napkin "can cause air trapped within the wrapper 160 to rupture the releasable seals 200" (see column 6, lines 29 and 30).

In view of the foregoing, it is respectfully submitted that the Minton et al. patent fails to teach or suggest the absorbent article of claim 1, and, therefore, that claim 1 is patentable. In addition, claims 2, 4, and 9 depend from claim 1. Each of these dependent claims recites additional features of the invention. For reasons analogous to those presented in relation to claim 1, it is respectfully submitted the Minton et al. patent also fails to teach or suggest the absorbent article of claims 4, 5, and 9, and, therefore, that claims 4, 5, and 9 are patentable.

#### Rejections in view of Meixner

The Meixner patent fails to teach or suggest packaging a single compressed absorbent article within a single packaging. Rather, Meixner claims that his method may be used to package diapers. This is a conventional packaging system that is used to package a plurality of diapers into plastic packaging that is then either sold within the packaging or repackaged into cardboard packaging.

Accordingly, the Meixner system fails to teach or suggest an absorbent article that is compressed and then packaged while compressed as recited in claim 1, or a method of packaging a single absorbent article as recited in claim 16.

It is respectfully submitted that the Meixner patent fails to teach or suggest the absorbent article of claim 1 and the method of claim 16, and, therefore, that claims 1 and 16 are patentable. In addition, claims 2, 4, and 9 depend from claim 1, and claims 19 and 20 depend from claim 16. Each of these dependent claims recites additional features of the invention. For reasons analogous to those presented in relation to claims 1 and 16, it is respectfully submitted the Meixner patent also fails to teach or suggest the absorbent article of claims 4, 5, and 9, and the methods of claims 19 and 20, and, therefore, that claims 4, 5, 9, 19, and 20 are patentable.

### REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 5, 16, and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,936,460 to Meyer. Applicant traverses these rejections.

#### Requirements for Obviousness

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted prima facie obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the prima facie case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a prima facie case of obviousness is established when the Patent Office provides:

- a) one or more references
- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of obviousness is not established. In the instant case, it is respectfully submitted that the Meyer patent fails to meet these requirements.

#### **The Cited Reference**

U.S. Patent No. 5,462,166 to Meyer discloses a shelf or counter display 10 for display of a soft toy 12 and for holding a plurality of individual packages 14 each containing a soft toy 12 in the compressed state. The toy 12 is constituted by a compressible filler or stuffing and a

flexible outer skin on which characterizing visual features such as eyes and a nose are printed. The packages 14 each have a transparent, gas impervious front sheet 15a and a gas impervious rear sheet 15b which are sealed together throughout a continuous area surrounding a soft toy 12 located between the front and rear sheets. The toy 12 in each package is compressed from front to back to twenty percent or less of its unstressed thickness and a vacuum is drawn between the front and rear sheets thereby to hold the toy in the compressed state. (See column 2, lines 22–37, and FIGS. 1–3 and 5.)

The display 10 may be seen to comprise a pair of trays 16 and 17 located in side-by-side relationship and an upstanding rear wall 20 which extends above the tops of the packages 14 to provide a space for containing descriptive printed matter. The tray 16 has a bottom 21 and upstanding forward wall 22 and a pair of triangular side walls 24 and 25 which extend a short distance forwardly of the front wall 22 and terminate at the front edge of the bottom panel 21. The tray 17 includes a front wall 28 and a pair of side walls 30. The wall 28 is located farther forward than is the wall 22 to provide a section in which one of the toys 12 may be placed in its uncompressed unpackaged state. (See column 2, lines 38–50, and FIGS. 1 and 6.)

### **Discussion**

Independent claims 1 and 16 are discussed above. The Meyer patent fails to teach or suggest reconfiguring an absorbent article as recited in claims 1 and 16. Rather, Meyer teaches compressing a stuffed toy. Indeed, Meyer is completely silent as to any element of his invention being absorbent. Clearly, the Meyer patent does not disclose the absorbent article of claim 1 and the method of packaging an absorbent article of claim 16.

Accordingly, it is respectfully submitted that the Meyer patent fails to teach or suggest the absorbent article of claim 1 and the method for packaging absorbent articles of claim 16, and, therefore, that claims 1 and 16 are patentable.

In addition, claims 4, 5, and 9 depend from claim 1, and claims 19 and 20 depend from claim 16. For reasons analogous to those presented in relation to claims 1 and 16, it is respectfully submitted the Meyer patent fails to teach or suggest the absorbent article of claims 4, 5, and 9 and the methods of claims 19 and 20, and, therefore, that these claims are also patentable.

**CLOSING REMARKS**

It is respectfully submitted that the subject application, including claims 1, 4, 5, 9, 16, 19, and 20, is in condition for allowance. Confirmation of the allowance is respectfully requested.

The Examiner is invited to contact the undersigned if he believes there are any issues which remain, preventing the allowance of the application.

Respectfully submitted,

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17744 Skypark Circle, Suite 295  
Irvine, California 92614  
Telephone: (949) 752-9525



Eric K. Saterno  
Registration No. 40,159